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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,088	12/29/2000	Douglas E. Love	7000-051	5020
27820	7590	05/20/2004	EXAMINER	
WITHROW & TERRANOVA, P.L.L.C. P.O. BOX 1287 CARY, NC 27512			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,088

Applicant(s)

LOVE ET AL.

Examiner

Igor Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-11,13,15,16,18-20,22,24-28,30,32,33,35-37,39,41-45,47,49,50 and 54-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Continuation of Disposition of Claims: Claims pending in the application are 1-3,5,7-11,13,15,16,18-20,22,24-28,30,32,33,35-37,39,41-45,47,49,50 and 54-56.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 5, 7-11 and 13-16 are rejected under 35 U.S.C. 101 because the claimed method for cost sharing of toll calls does not recite a limitation in the technological arts. The independently claimed steps of: *receiving a request for toll sharing, the request originating in a telephony device; receiving proposed toll sharing parameters, initiating a toll call, informing the call recipient, receiving a decision, and apportioning the cost for the toll call*, are abstract ideas which can be performed mentally without interaction of a physical structure. The method step: *"receiving a request for toll sharing, the request originating in a telephony device"* may be understood as merely talking over the phone. However, the claimed invention must utilize technology in a non-trivial manner (Ex parte Bowman, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 18-20, 22, 24-28, 30, 32-33 and 55 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The claimed system is missing any structural elements which would provide functionality of the system.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 7-11, 13, 15, 18-20, 22, 24-28, 30, 32-33, 35-37, 39, 41-45, 47, 49 and 54-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Kalmanek, Jr. et al. (6,577,718).

Kalmanek, Jr. et al. (hereinafter Kalmanek) teaches a call forwarding method and system with split billing, comprising:

Claims 1, 18 and 35, receiving a request for toll sharing, the request originating in a telephony device; receiving proposed toll sharing parameters, initiating a toll call, informing the call recipient, receiving a decision (C. 11, L. 41-57); and apportioning the cost for the toll call (C. 2, L. 5-7).

Claims 2 and 36, generating billing information for each call participant (C. 25, L. 25-34).

Claims 3 and 37, see claim 1.

Claims 5 and 39, calling parameters for a call recipient are calculated in accordance with predefined function (C. 27, L. 53-55).

Claims 7-9 and 41-43, see claim 5.

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Claims 10-11 and 44-45, toll sharing parameters are defined to apply to at least one portion of the toll call (C. 2, L. 5-7).

Claims 13 and 47, facilitating interaction with the call originator (C. 12, L. 26-28).

Claims 15 and 49, request is a code dialed by the call originator (C. 13, L. 51-52).

Claims 54 and 56. See claim 1.

Claims 19-20, 22, 24-28, 30, 32-33 and 55, see claim 1. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus as described the limitations of the claims do not distinguish the claimed apparatus from the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalmanek.

Claims 16 and 50. Kalmanek teaches all the limitations of claims 16 and 50, except specifically teaching using operator assistance to initiate said call.

Official notice is taken that it is well known in telecommunication industry to use operators for assistance.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kalmanek to include using operator assistance to initiate said call, because it would allow said call initiators to ask said operator questions associated with sharing cost, thereby improve customer service.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 5, 7-11, 13, 15, 16, 18-20, 22, 24-28, 30, 32, 33, 35-37, 39, 41-45, 47, 49, 50 and 54-56 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306

[Official communications; including After Final communications labeled "Box AF"]

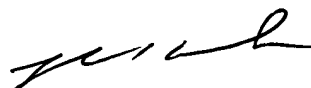
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

DR



JOHN G. WEISS
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